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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,462	10/31/2003	Jay S. Walker	97-007-C1	4855
22927 7590 11/10/2010 WALKER DIGITAL MANAGEMENT, LLC 2 HIGH RIDGE PARK STAMFORD, CT 06905				
EXAMINER				
PRESTON, JOHN O				
ART UNIT		PAPER NUMBER		
3691				
MAIL DATE		DELIVERY MODE		
11/10/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/699,462

Applicant(s)

WALKER ET AL.

Examiner

JOHN O. PRESTON

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2010.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 63-76 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 63-76 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on October 31, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB06)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2010 has been entered.

DETAILED ACTION

2. Claims 1 and 63-76 are presented for examination. Applicant filed an amendment on September 25, 2010. Claims 73-74 were canceled. Claims 1, 68, 72, 75, and 76 were amended. After careful consideration of applicant's arguments/amendments, the examiner maintains the grounds of rejection for claims 1, 63-72, 75, and 76 under 35 USC 102 and 35 USC 103. The rejection of claims 1, 63-72, 75, and 76 is a non-final rejection of the claim(s).

Response to Arguments

3. Applicant argued that Humble does not disclose the limitation of performing a comparison to establish whether a financial account may be adjusted an amount based at least in part on the adjustment value, or performing a comparison to establish whether a credit account of the customer may be charged the upsell price. Examiner respectfully disagrees. Humble discloses crediting an account based on a coupon, which is an adjustment of a financial account based at least in part on an adjustment value, the value of the coupon being the adjustment value (Humble: col 2, lines 50-65). Crediting a financial account to account for a coupon also implies a debiting of the account for the actual transaction. Humble also discloses performing a comparison to determine whether an account may be debited (Humble: col 3, lines 50-65). Humble teaches comparing product codes to determine whether a product is used in a promotional. In conjunction with the teaching of creating an account based on a coupon, Humble

implies performing a comparison to determine whether an account may be debited. Therefore, Examiner finds Applicant's argument non-persuasive.

4. Applicant argued that Humble does not disclose the claimed feature of charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price. Examiner respectfully disagrees. Humble teaches offering for present purchase a product other than the product actually selected for purchase, which implies an upsell where the purchase price would be increased to match the upsell price and charged to the customer's account (Humble: col 2, lines 50-65). Therefore, Examiner finds Applicant's argument non-persuasive.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 63, 65-69, and 72-76 are rejected under 35 U.S.C. 102(b) as being anticipated by Humble (4,825,045).

Claim 1: Humble discloses the following limitation(s):

- receiving from a first merchant an indication of a purchase having an associated purchase price and at least one purchase parameter; (Humble: col 1, lines 40-60)
- determining, by a central controller, an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, upsell having associated therewith an upsell price; (Humble: col 2, lines 50-65)

- performing, by the central controller, a comparison to establish whether a credit account of the customer may be charged the upsell price; (Humble: col 3, lines 50-60)
- transmitting a product identifier for specifying upsell; (Humble: col 2, lines 50-65)
- receiving a selection signal indicative of whether indicating that the supplementary product upsell is accepted; and (Humble: col 1, lines 40-60)
- charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price (Humble: col 2, lines 50-65)

Claim 63: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 63. (NEW) The method of claim 1, in which transmitting the product identifier for specifying the upsell comprises: transmitting, by the central controller, the product identifier for specifying the upsell. (Humble: col 2, lines 50-65)

Claim 65: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 65. (NEW) The method of claim 1, in which the upsell comprises an offer to the customer for a subscription. (Humble: col 2, lines 20-65)

Claim 66: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 66. (NEW) The method of claim 1, in which the upsell comprises an offer to the customer for a discount. (Humble: col 1, lines 40-65)

Claim 67: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 67. (NEW) The method of claim 1, in which the upsell comprises a supplementary product. (Humble: col 2, lines 20-65)

Claim 68: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 68. (NEW) The method of claim 1, further comprising: determining a merchant financial account in dependence on the upsell; and adjusting a balance of the merchant financial account in dependence on the upsell price. (Humble: col 2, lines 15-65)

Claim 69: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 69. (NEW) The method of claim 1, in which the at least one purchase parameter comprises a customer account identifier for specifying a customer account. (Humble: col 2, lines 15-65)

Claim 72: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 72. (NEW) The method of claim 1, in which the at least one purchase parameter comprises a credit account identifier for specifying the credit account. (Humble: col 2, lines 15-65)

Claim 73: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 73. (NEW) The method of claim 1, in which adjusting a balance of the financial account in dependence on the adjustment value comprises: crediting the adjustment value to the balance of the financial account. (Humble: col 2, lines 15-65)

Claim 74: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble further discloses the following limitation(s):

- 74. (NEW) The method of claim 1, in which adjusting a balance of the financial account in dependence on the adjustment value comprises: debiting

the adjustment value from the balance of the financial account. (Humble: col 2, lines 15-65)

Claim 75: Humble discloses the following limitation(s):

- receiving from a first merchant an indication of a purchase having an associated purchase price and at least one purchase parameter; (Humble: col 1, lines 40-60)
- determining, by a central controller, an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, the upsell having associated therewith an upsell price; (Humble: col 2, lines 50-65)
- performing, by the central controller, a comparison to establish whether a credit account of the customer may be charged the upsell price; (Humble: col 3, lines 50-60)
- transmitting a product identifier for specifying the upsell; (Humble: col 2, lines 50-65)
- receiving a selection signal indicating that the upsell is accepted; and (Humble: col 1, lines 40-60)
- charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price. (Humble: col 2, lines 50-65)

Claim 76: Humble discloses the following limitation(s):

- a processor; and a storage device in communication with the processor, the storage device storing instructions configured to direct the processor to perform steps of: (Humble: Fig:1)
- receiving from a first merchant an indication of a purchase having an associated purchase price and at least one purchase parameter; (Humble: col 1, lines 40-60)

- determining an upsell from a second merchant to offer to the customer based on the at least one purchase parameter, the upsell having associated therewith an upsell price; (Humble: col 2, lines 50-65)
- performing a comparison to establish whether a credit account of the customer may be charged the upsell price; (Humble: col 3, lines 50-60)
- transmitting a product identifier for specifying the upsell; (Humble: col 2, lines 50-65)
- receiving a selection signal indicating that the upsell is accepted; and (Humble: col 1, lines 40-60)
- charging the upsell price to the credit account of the customer, the upsell price being in addition to the purchase price. (Humble: col 2, lines 50-65)

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over Humble.

Claim 64: Humble discloses the limitation(s) as shown in the rejection of claim 1. Humble does not disclose the limitation below. In regard to the following limitation(s):

- 64. (NEW) The method of claim 1, in which the upsell comprises an offer to the customer for a service agreement.

It would have been obvious to one having ordinary skill in the art at the time the invention was made, in light of the prior art disclosed in Humble (col 2, lines 20-65), to modify Humble in order to provide an upsell comprised of an offer to the customer for a service agreement because one having ordinary skill in the art at the time the invention was made could have performed such a modification with a reasonable expectation of success and predictable results.

7. Claims 70 and 71 are rejected under 35 U.S.C. 103(a) as being unpatentable over Humble in view of Deaton (5,621,812).

Claim 70: Humble discloses the limitation(s) as shown in the rejection of claim 69. Humble does not disclose the remaining limitation. However, Deaton teaches:

- 70. (NEW) The method of claim 69, further comprising: determining, from the customer account identifier, at least one previous purchase; and in which the step of determining an upsell comprises: determining an upsell to offer based on the at least one previous purchase. (Deaton: col 66, line 30 – col 67, line 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Humble with the elements as taught by Deaton because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Claim 71: Humble discloses the limitation(s) as shown in the rejection of claim 69. Humble does not disclose the remaining limitation. However, Deaton teaches:

- 71. (NEW) The method of claim 69, further comprising: determining, from the customer account identifier, at least one previously- offered upsell; and in which the step of determining an upsell comprises: determining an upsell to offer based on the at least one previously-offered upsell. (Deaton: col 66, line 30 – col 67, line 30)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the elements cited in Humble with the elements as taught by Deaton because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **John Preston** whose telephone number is **571.270.3918**. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ALEXANDER KALINOWSKI** can be reached at **571.272.6771**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

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Examiner, Art Unit 3691
November 3, 2010

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Primary Examiner, Art Unit 3691